

REMARKS

Remaining Claims

Twenty-four (24) claims (Claims 159 – 182) remain pending in this application through this Amendment. Claims 159, 163, 166 – 168, 171 – 173, and 175 have been amended herein. As explained in more detail below, the amended claims are enabled by the specification and are not anticipated or obvious over the cited art, either individually or in combination.

Acknowledgement of Examiner's Amendment

On page 2 of the Office Action, the Examiner cancelled Claim 1 by Examiner's Amendment. Applicants acknowledge this Amendment and thank the Examiner for kindly pointing out that this claim was drawn to an invention allowed in the grandparent case.

Rejection of Claims 159 – 182 Under 35 U.S.C. §112, First Paragraph

Claims 159 – 182 stand rejected under 35 U.S.C. §112, first paragraph, as based on a disclosure which is not enabling. Specifically, the Examiner maintains that the lack of continuous pathways for ion and oxygen permeability, running from the inner to the outer surface of the presently claimed contact lens, the pathways or continuous phases is critical or essential to the practice of the invention. Because this limitation is not included in the claims, they are not enabled by the disclosure. With regard to the method claims, the Examiner maintains that the presence of an initiation or polymerization step wherein polymerization takes place other than in the absence of oxygen is critical or essential to the practice of the invention. Because this limitation is not included in the method claims, they are not enabled by the disclosure.

Claims 159, 163, 168, and 175 (the four pending independent claims) have been amended to require a "continuous pathway" between the surfaces "for oxygen transmission therethrough."

With regard to the rejection of the method claims, Applicant points out that the presence of an initiation or polymerization step wherein polymerization takes place other than in the absence of oxygen is not critical or essential to the practice of the invention. For example, the Alsacon material of the present invention exemplified in the "A" series of Examples in the present application does not require a degassing step prior to polymerization. Therefore, Applicant submits that Examples are provided which demonstrate that this step is not critical to the entirety of the claimed subject matter.

Applicant therefore respectfully requests that this rejection be withdrawn.

Rejection of Claims 157 – 160, 163 – 164, 167 – 169, and 171 – 174 Under 35 U.S.C. §102(b)/§103(a) – Valint, Jr., et al.

Claims 157 – 160, 163 – 164, 167 – 169, and 171 – 174 stand rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under §103(a) as obvious over U.S. Patent No. 5,219,965 to *Valint, Jr., et al.* While the Office Action states that Claims 157 – 160 are rejected, Applicant assumes that Examiner intended 159 – 160, as Claims 157 and 158 are no longer pending in this Application. In any event, the Examiner states that while *Valint, Jr., et al.* do not specifically disclose the oxygen or water permeability of the present claims, they do disclose silicon-containing monomers as modifiers for the surface of hydrophilic gel-type contact lenses which comprise the polymerization product of a urethane-functional siloxane methacrylate with comonomers comprising hydrophilic N-vinyl pyrrolidone, hydroxyethyl methacrylate or acrylamide monomers.

However, Applicants have amended the claims to specify that the core material has a “continuous pathway” between the surfaces “for oxygen transmission therethrough.” *Valint, Jr., et al.* does not teach or suggest a co-continuous core material as described and claimed by the Applicants. Therefore, Applicants respectfully request that this rejection be withdrawn.

Rejection of Claims 161 – 162, 165 – 166, 170, and 174 Under 35 U.S.C. §103(a) – Valint, Jr., et al. in view of Mueller, et al.

Claims 161 – 162, 165 – 166, 170, and 174 stand rejected under 35 U.S.C. §103(a) as being obvious over *Valint, Jr., et al.* in view of U.S. Patent No. 4,486,577 to *Mueller, et al.* Specifically, the Examiner states that while *Valint, Jr., et al.* do not disclose the plasma treating of soft contact lenses, *Mueller, et al.* disclose a surface-treated biphasic polymerized mixture of siloxanes and vinyl polymers containing both hydrophobic and hydrophilic monomers.

As stated above in response to Examiner’s §102(b)/ §103(a) rejection, Applicants have amended the claims to specify that the core material has a “continuous pathway” between the surfaces “for oxygen transmission therethrough.” Neither *Valint, Jr., et al.* nor *Mueller, et al.* teach or suggest a co-continuous core material as described and claimed by the Applicants. Therefore, Applicants respectfully request that this rejection be withdrawn.

Furthermore, while *Mueller, et al.* do teach the plasma coating of soft contact lenses, they do not teach the plasma coating of hydrogel lenses. It would not have been obvious to one of skill in the art at the time of the invention to apply the teachings of

Mueller, et al. to hydrogel lenses because these the use of such techniques on hydrogels can have adverse effects on ion and water permeability. This provides an additional and independent basis for withdrawal of the Examiner's rejection.

Provisional Rejection of Claims 163 – 174 for Double Patenting

Claims 163 – 174 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 159 – 167 of copending application Serial No. 09/108,714. The Examiner points out that the only difference between the presently claimed lens and those lenses claimed in the application Serial No. 09/108,714 lies in the materials themselves. Applicants note that application Serial No. 09/108,714 has since issued as U.S. Patent No. 5,965,631 and thus, assume that this rejection is no longer "provisional."

In any event, Applicants respectfully submit that the present claims are patentably distinct from those of U.S. Patent No. 5,965,631 because the present claims require "hydrophilically modified surfaces." Such surfaces are absent in the '631 patent, and the addition of such surfaces is not merely an obvious variation. Therefore, Applicants request that this rejection be withdrawn.

CONCLUSION

In view of the foregoing and in conclusion, Applicants submit that the 35 U.S.C. §§112, 102, and 103 rejections set-forth in the Office Action have been overcome, and that the pending claims are enabled and not anticipated or obvious over the cited art, either individually or in combination. Applicants request reconsideration and withdrawal of the rejections set-forth in the Office Action. Should the Examiner believe that a discussion with Applicants' representative would further the prosecution of this application, the Examiner is respectfully invited to contact the undersigned.

Please address all correspondence to Michael W. Glynn, Novartis Corporation, Patent and Trademark Department, 564 Morris Avenue, Summit, NJ 07901. The commissioner is hereby authorized to charge any other fees with may be required under 37 C.F.R. §1.16 and 1.17, or credit any overpayment, to Deposit Account No. 09-0134.

Respectfully submitted,



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